

REMARKS/ARGUMENTS

Reconsideration of this application in light of the foregoing amendments, following comments and submissions are respectfully requested.

Initially, with regard to the examiner's objections to claim 33 and Page 9 of the specification, Applicants have amended claim 33 to delete the "numeral 1" and has amended Page 9 of the specification to correct the material composition subscripts. With regard to the specification, Applicants submit herewith a substitute specification which has been prepared in accordance with U.S. practice by deleting reference to the claims in the specification and adding the appropriate headings. In addition, the Brief Description of the Drawing has been moved to an appropriate location in accordance with U.S. practice. The substitute specification does not contain any new matter.

The examiner rejected previously submitted claims 16-33 under 35 U.S.C. 112, first paragraph. Applicant respectfully traverses this rejection. The examiner in rejecting claims 16-33 under 35 U.S.C. 112, first paragraph sets forth in his rejection that, in the examiner's opinion, the specification does not enable one skilled in the art to make or use the invention "because in order to make or use the invention one must determine the enlargement factor, which can not be readily

determined because there is no teaching as to how to determine the "achievable relative density after sintering"." Applicants respectfully traverse this rejection. In support of Applicants traversal, Applicants attach hereto Exhibits A, B, C and D. Exhibit A is a letter dated from Dr. John W. Halloran, professor in ceramics at the University of Michigan. Dr. Halloran sets forth in his letter that it is well within the realm of the skilled artisan when reading the instant patent application to determine the "enlargement factor" as defined in the application. With regard to the term "achievable relative density" Dr. Halloran sets forth on Page 2 of his letter that this term is clear and readily attainable to one skilled in the art when viewing the instant specification. Exhibit B is from Dr. Sigmund, a professor of material science at the University of Florida. Dr. Sigmund indicates that he has read the comments of the examiner in his office action and believes the examiner is wrong. Dr. Sigmund concludes that somebody skilled in the art can readily determine the achievable relative density after sintering as "it's a common knowledge that doesn't require any extra teaching" than that which is given in the instant application. Exhibit C is from Dr. Gary Messing, distinguished professor of ceramics at the University of Pennsylvania. Dr. Messing likewise indicates that he believes the examiner's

conclusion is wrong in that one skilled in the art when viewing the instant specification can readily determine "the achievable relative density after sintering". Applicant has received other letters from other professors indicating the foregoing.

Applicants have not submitted these letters executed by the professors in declaration form as it is not believed to be necessary to be probative of the issue at hand; however, if declarations requested by the examiner, Applicants will prepare the necessary declarations for signature by each of the professors whose letters are submitted herewith as Exhibits A, B and C. Exhibit D is from the European patent and includes claims 1-15.

With regard to the rejection of claim 33 under 35 U.S.C. 112, first paragraph, this rejection is traversed because claim 33 specifically sets forth process steps for determining the "achievable relative density". This one example of how to determine the achievable relative density of a ceramic material is believed to be readily apparent to one of skilled in the art (as evidenced by the Exhibits attached) when reading the specification of the instant application. Accordingly, while the specific process step set forth in claim 33 are not specifically identified in the specification, it is submitted that they need not be identified in the specification because

they are readily apparent to one of ordinary skill in the art. Accordingly, it is believed that the examiner's rejection of claim 33 under 35 U.S.C. 112, first paragraph is without merit.

With regard to the objection of claims 16-33 under 35 U.S.C. 112, second paragraph, again the examiner's rejection is traversed. Applicants do not argue that the achievable relative density after sintering is dependent on the factors raised by the examiner in paragraph 5 of his office action. This is clear and known to one of ordinary skill in the art. However, for particular ceramic composition of particular size process of the particular sintering temperature for a particular sintering time under a particular sintering pressure, one can determine the achievable relative density for that particular ceramic blank. With regard to the examiner's comment concerning claims 16 and 32 as being indefinite, again Applicants traverse the examiner's rejection. As noted above and as evidenced by the Exhibits attached the achievable relative density after sintering readily be obtained by one of ordinary skill in the art. Relative in density of the preprepared need only be measured. The enlargement factor can then be determined in accordance with the formula of claims 16 and 32. Claims 16 and 32 referred to a preprepared blank of material. Thus, the process of claim 16 and claim 32 is carried out on a blank of porous material.

Applicants are lost as to how these claims are indefinite under 35 U.S.C. 112, second paragraph. What the examiner finds to be contradictory is not understood. Claims 16 and 32 are consistent with the specification.

The examiner has responded to Applicant's request in further detail in paragraph 6 of the examiner's action. Again, as noted above, Applicants do not disagree with the examiner that the achievable relative density is dependent on a plurality of conditions. However, all of these conditions are known to one of ordinary skill in the art and thus, for a particular material processed in the particular way for a particular amount of time the achievable relative density can readily be determined. The examiner's position is respectfully submitted to be untenable. Again attention is drawn to the attached Exhibits.

In addition to the foregoing, Applicants submit new claims 35-40. Claims 35-40 are claims which have been allowed in the corresponding European application which has issued as a European patent. The claims have been modified in form only so as to comply with U.S. practice. The substance of newly presented independent claim 35 is consistent with the independent claim allowed in the European patent. Claim 35 complies with the formal requirements of both the first and

second paragraphs of 35 U.S.C. 112. It is submitted that claim 35 sets forth a particular process for machining a blank of press ceramic powder which is not at all contemplated by the prior art reference previously cited and not now applied in the instant application.

In light of the foregoing, it is submitted that all of the claims as pending patentably define over the art of record and an early indication of same is respectfully requested.

An earnest and thorough attempt has been made by the undersigned to resolve the outstanding issues in this case and place same in condition for allowance. If the Examiner has any questions or feels that a telephone or personal interview would be helpful in resolving any outstanding issues which remain in this application after consideration of this amendment, the Examiner is courteously invited to telephone the undersigned and the same would be gratefully appreciated.

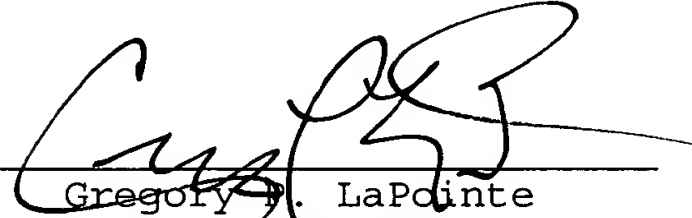
It is submitted that the claims as amended herein patentably define over the art relied on by the Examiner and early allowance of same is courteously solicited.

If any fees are required in connection with this case, it
is respectfully requested that they be charged to Deposit
Account No. 02-0184.

Respectfully submitted,

Frank Filser et al.

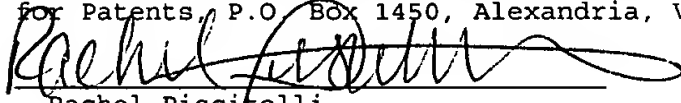
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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on April 30, 2004.



Rachel Piscitelli